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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,226

08/03/2006

Peter Kruger

KRUGER1

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1444 7590 07/09/2007  
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EXAMINER

PARVINI, PEGAH

ART UNIT

PAPER NUMBER

1755

MAIL DATE

DELIVERY MODE

07/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/588,226

Applicant(s)

KRUGER ET AL.

Examiner

Pegah Parvini

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1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-18 is/are rejected.
- 7) ☒ Claim(s) 19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 20060803
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 11-13, and 17 are provisionally rejected on the ground of nonstatutory double patenting over claims 1, 3-4, and 20 of copending Application No. 10/525,395.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: both applications claim a

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metal pigment for a cosmetic preparation such as lipstick, nail polish, eye shadow, hair colorant, rouge, etc. in which the pigment contains a metallic substrate which is encapsulated by a layer produced by the sol-gel process wherein the layer is an inorganic material such as silicon oxide.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear whether the percentages of metal pigment in the cosmetic preparation are claimed in weight percent or molar percent.

***Claim Objections***

5. Claims 19 and 20 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims 19 and 20 have not been further treated on the merits.

The language of the claims may be changed so that they would read as "A cosmetic preparation as in any of the preceding claims, in which..."

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 11-12, and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,213,618 to Souma et al.

8. Regarding claim 11, Souma et al. teach a chromatic color metal flake pigment, wherein the metal of the base flakes may be aluminum, tin, iron, titanium, and more, and in which the metal flake is coated with a coating layer of a titanium oxide deposited by the hydrolysis of a hydrolysable organic titanate ester; in addition, Souma et al. disclose a cosmetic preparation of the disclosed pigment (column 2, lines 25-30; column 6, lines 20-25; column 8, lines 54-60).

Although the reference does not expressly disclose that the metal pigment is water-wettable, the reference discloses a substantially identical composition for the metal pigment and identical composition cannot have mutually exclusive properties. Therefore, the claimed property is assumed to be inherent to the composition of the reference. See MPEP § 2112.01.

9. Regarding claims 12 and 17, Souma et al. disclose that the cosmetic preparation of the disclosed pigment include makeup cosmetics such as rouges, eye shadows, and manicure enamels (column 9, lines 20-22).

10. Regarding claims 14-15, Souma et al. disclose a metal flake pigment coated with metal oxide through the sol-gel process and in which the disclosed composition is used in cosmetic preparation; additionally, the disclosed pigment has high hiding power and is capable of expressing a highly aesthetic coloring effect (column 2, lines 14-18, 25-30; column 6, lines 20-24; column 8, lines 54-60).

Even though the reference does not expressly disclose the properties recited in claims 14-15, the reference disclosed an identical composition, and identical compositions cannot have mutually exclusive properties. Therefore, the claimed properties of imparting a uniform optical impression of the skin and covering up the skin impurities are assumed to be inherent to the composition of the reference. See MPEP § 2112.01.

11. Regarding claim 16, Souma et al. disclose that the cosmetic preparation contains the chromatic-color metal flake pigment in an amount, preferably, from 0.5 to 30% by weight on the overall amount of the composition (column 9, lines 4-10). It is noted that claim 16 recites amount of particularly preferably of 0.2% to 5%.

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12. Claims 11-13 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Application Publication No. 2003/0051634 to Takahashi.

13. Regarding claim 11, Takahashi teaches a high-chromatic flaky pigment in which the flaky substrate is preferably a metal pigment coated with a silicon dioxide film ([0008], [0014]). Takahashi discloses that coating the flaky substrate is done through the sol-gel method ([0026], [0034]). Furthermore, Takahashi discloses that the pigment is used in cosmetics ([0017]).

It is noted that although Takahashi does not expressly disclose that the pigment is water-wettable, the reference discloses a substantially identical composition as claimed in claim 11 and identical compositions cannot have mutually exclusive properties. Therefore, the claimed property is assumed to be inherent to the composition of the reference. See MPEP § 2112.01.

14. Regarding claims 12 and 17, Takahashi teaches that the disclosed invention is used in cosmetics formulations such as hair cosmetics, lipstick, foundation, rouge, mascara, nail enamel, eyebrow pencils, eye shadow, eye liner, hair color and more ([0085]).

15. Regarding claim 13, Takahashi discloses that the metal substrate is coated with silicon dioxide ([0014]).

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16. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,931,996 to Reisser et al.

17. Regarding claim 11, Reisser et al. disclose a process of production of highly stable pigments in which the substrate is aluminum in flake or other forms coated with a colored pigment-bearing metal oxide layer wherein the coating is applied by means of a sol-gel process (column 3, lines 54-67; column 7, lines 6-8). Furthermore, the reference discloses that the disclosed pigment is used in cosmetic preparations (column 7, lines 13-16).

Although the reference does not expressly disclose that the metal pigment is water-wettable, it discloses a substantially identical composition for the metal pigment and identical compositions cannot have mutually exclusive properties. Therefore, the claimed property is assumed to be inherent to the composition of the reference. See MPEP § 2112.01.

18. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,261,955 to Nadkarni.



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19. Regarding claim 11, Nadkarni teaches coloring metal flake, aluminum flake, which is coated with an inorganic coating over the entire surface of each flake pigment through the sol-gel process (column 3, lines 42-55).

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Souma et al. in view of JP 55004358.

22. Regarding claim 18, Souma et al. teach a metal flake pigment coated with a metal oxide layer through the sol-gel process wherein the disclosed pigment has a high hiding power, and capable of expressing a highly aesthetic coloring effect wherein the said pigment is used in make-up cosmetics such as rouge, eye shadow and manicure enamels (column 2, lines 15-18, 25-30; column 9, lines 20-22). In addition, Souma et al. disclose that the amount of metal in the overall composition is, preferably, from 0.5 to 30 wt% (column 9, lines 4-9).

Souma et al. does not disclose that the cosmetic pigment is based on nitrocellulose.

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JP 55004358 discloses a nail varnish preparation, which is made of metal foil coated with a transparent resin layer wherein the nail varnish further contains nitrocellulose (Abstract).

At the time of the invention, it would have been obvious to person of ordinary skill in the art to modify Souma et al. in order to include nitrocellulose in the disclosed metal pigment composition as that taught by JP55004358 motivated by the fact that JP 55004358 teach that nitrocellulose is the effective ingredient in the absence of alcohol in the nail varnish.

### ***Conclusion***

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent Application Publication No. 2004/0057918 to Chodorowski-Kimmes

US Patent No. 5,718,753 to Suzuki et al.

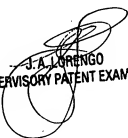
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pegah Parvini whose telephone number is 571-272-2639. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PP

  
J. A. LORENZO  
SUPERVISORY PATENT EXAMINER